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NEIFELD Docket No.: PIP-69A-KATZ

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: Gary Katz

GROUP ART UNIT: 3622

SERIAL NO.: 09/776,714

CONFIRMATION NO.: 2896

EXAMINER: Raquel Alvarez

FILED: 2/6/2001

FOR: Method and System for Timing Promotions Based on a Prior Receipt of Promotions

37 CFR 41.41 REPLY BRIEF

BOX STOP APPEAL BRIEF - PATENTS

COMMISSIONER FOR PATENTS

P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

Sir:

Pursuant to 37 CFR 41.41, appellant replies to the examiner's answer mailed June 27, 2005. This reply brief incorporates by reference the appellant's 37 CFR 41.37 appeal brief filed April 7, 2004. Appellant submits no new amendments or evidence.

### **37 CFR 41.37(c)(1)(vii) Argument**

#### **A. The Withdrawal of Rejections of 28-32**

It is noted that the examiner has “withdrawn” the rejections of claims 28-32 over 101 in the examiner’s answer. This is an admission that those rejections were improper. The Board should therefore reverse the rejections of claims 28-32 based upon 35 USC 101.

#### **B. The Rejection of Claims 1-58 and 62-65**

In the examiner’s answer mailed 6/27/2005 at page 10 lines 5-7, the examiner makes the following additional argument in support of the rejections of claims having the limitation “determining a time at which a promotion is to be provided based upon one or more parameters related to promotions received by said consumer”:

The Examiner disagrees with Applicant because in Swiss [sic], the time to display a related promotion is when the system identifies the user viewing a particular ad. [Examiner’s Answer mailed 6/27/2005 page 10 lines 5-7; interpolation supplied.]

First, this assertion that Swix discloses concurrently displaying two promotions (1) is not what Swix discloses and (2) makes no sense.

Second, the examiner makes assertions in the examiner’s answer inconsistent with the assertions in the office action appealed from. The examiner had previously asserted in the office action appealed from that Swix taught that it was when a user had watched / received a commercial that the system determined that a related commercial should be displayed. However, the examiner impliedly suggests in the examiner’s answer that Swix teaches that it is when a user is watching / receiving a commercial that the system determines that it is the right time to display a related commercial.

The examiner now states that Swix teaches the following:

For example, when a user is watching/receiving a commercial for outdoor

adventure gear then the system determines that is the right time to display a related commercial for a sport utility vehicle in which the user can carry out the adventure gear previously watched/received by the customer (col. 12, lines 43-60).

[Examiner's answer page 10 lines 7-10.]

In reply, the appellant respectfully points out that the examiner mischaracterizes Swix and in any case Swix does not disclose or suggest what is claimed.

The examiner's factual assertion is incorrect. Swix does not disclose or suggest that the time to display a related promotion is when the system identifies the user viewing a particular advertisement. As was explained in the appeal brief, Swix clearly discloses that the time that Swix determines to display an advertisement is when there is an open advertisement slot, such as before or after a movie, not, as the examiner now asserts, when "the system identifies the user viewing a particular ad." See Swix column 9 lines 19-20 and column 12 lines 49-50. See, for example, Swix column 12 lines 53-59:

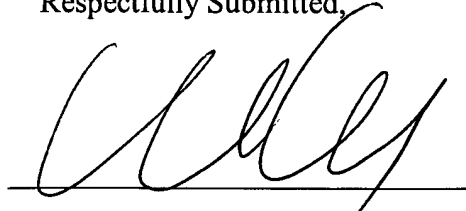
As an example, given the viewer's interest in outdoor adventures, a suitable advertisement would be a commercial for a sport utility vehicle with specialized accessories that carry outdoor adventure gear. The present invention would deliver this advertisement as a full screen video stream played prior to or after the showing of the feature movie presentation. Swix column 12 lines 53-59.

Thus, Swix does not display the ad when the user is viewing an ad. Instead, Swix teaches delivering the advertisement at a time prior to or after the showing of a feature movie presentation.

7/20/2005

DATE

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'R. Neifeld', written over a horizontal line.

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NAC

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